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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,662	12/22/2000	Lechoslaw Turski	102286-123	1433

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BOSTON, MA 02109

EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 07/29/2002 10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,662

Applicant(s)

TURSKI ET AL.

Examiner

Ruixiang Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-10 and 12 is/are rejected.
- 7) ☒ Claim(s) 14 and 18-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicants' election with traverse of Group I (Claims 1, 2, 4-6, 8-10, 12, 14, and 18-20) in Paper No. 9 filed on 05/29/2002 is acknowledged. The traversal is on the ground that the subject matter of Groups I and II is so closely related that a search of one group inevitably will reveal art relevant to the other and thus simultaneous search and examination would not be unduly burdensome. This is not found persuasive because while both AMPA receptors and kainite receptors belong to ionotropic glutamate receptors, the two types of receptors do have distinct entity and require separate search. Even if the search on one receptor may reveal the art relevant to the other receptor, examination of the two receptors requires separate consideration. Consequently search and examination constitute an unduly burden on the office.

Applicants further elected amino- or desamino-2,3-benzodiazepine for prosecution of Claims 8 and 9, and elected an interferon for prosecution of Claims 14 and 19.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicants' amendment filed in Paper No. 5 on 12/22/200 is acknowledged. The title of the application has been changed to read as "Treatment of demyelinating disorders". Claims 15-17 have been canceled, Claims 1-14 have been amended, and Claims 18-20 have been added. Claims 1-14 and 18-20 are pending, Claims 1, 2, 4-6, 8-10, 12, 14, and 18-20 are under consideration. All other claims are withdrawn

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from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on application PCT GB99 02112, filed on July 2, 1999 under 35 U.S.C. 119(a)-(d), and for PCT international applications (PCT GB 98/14380.3, filed on 07/02/1998; PCT GB 98/24393.4, filed on 11/06/1998) designating the U.S. for benefit under 35 U.S.C. 120.

### ***Drawings***

4. The drawings, Figs. 1-8, are accepted by the Examiner.

### ***Information Disclosure Statement***

5. The Information Disclosure Statement filed on May 7, 2001 in paper No. 6 is acknowledged. However, It is incomplete because form PTO-1449 (including 15 documents) and a copy of the International Search report have not been received by the Office. Applicants are required to submit a PTO-1449 form and to provide the references listed in the form.

### ***Claim Rejections—35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 2, 4-6, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Csuzdi et al. (U.S. Patent No. 6,323,187 B1, November 27, 2001; filed on July 31, 1998).

Csuzdi et al. teach condensed 2,3-benzodiazepine derivatives, including amino- or desamino-2,3-benzodiazepine, a composition comprising the compounds, and the use as AMPA receptor inhibitors (See, Abstract and Claims). Thus, the reference taught by Csuzdi et al. meets the limitations of Claims 1, 2, 4-6, 8, and 9.

8. Claims 1, 2, 4, 5, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller et al. (DE 4239816 A1, June 1, 1994).

Keller et al. teach an AMPA receptor channel blocker, Joro spider toxin, and a composition comprising the molecule (See, e.g., abstract). Thus, the reference taught by Keller et al. meets the limitations of Claims 1, 2, 4, 5, 10, and 12.

***Claim Objection—Minor Informalities***

9. Claims 1, 2, 4, 5, 8, 14, and 18-20 are objected to because of the following informalities: (a) Claims 1, 18, and 19 recite the abbreviation "AMPA" which should be spelled out in all independent claims for the interest of clarity; (b) there are two "." at the end of the Claim 2; (c) there is a typographic error in "benzodiazepine" in claim 8 (line 9); "with combined with" in claim 19 (line 4) also appears to be a typographic error. (d) Claims 1, 4, 5, 14, and 18-20 recite an unelected subject matter (an inhibitor of the interaction of glutamate with the kainite receptor).

Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].


All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility

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that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Ruixiang Li  
Examiner  
July 21, 2002



YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600